



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Henry ROSENTHAL

Group Art Unit: 3682

Application No.: 10/694,021

Examiner: V. LUONG

Filed: October 28, 2003

Docket No.: 116364

For: TAPERED GRIP FOR MOTORCYCLE HANDLEBAR

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal filed herewith, a pre-appeal brief conference is respectfully requested.

The rejection of claims 1-3 under 35 U.S.C. §103 will be challenged on Appeal. The March 31, 2005 Advisory Action states that the claim amendments made by the March 11, 2005 Amendment After Final Rejection ("the AAFR") will be entered for the purposes of Appeal. Based on the amendment to claim 1 and the remarks set forth in the AAFR, Applicant contends that claims 1-3 recite statutory subject matter.

The January 24, 2005 Office Action finally rejected claims 1-3 under 35 U.S.C. §103(a) over U.S. Design Patent D284,259 to Oury.

Applicant contends that the rejection of claims 1-3 set forth in the January 24 Final Office Action and the Advisory Action is erroneous. As such, Oury does not teach or suggest the features alleged by the Examiner, nor would it have been obvious to revise the claim of the applied design patent as alleged by the Examiner.

Specifically, Oury does not teach or suggest a hand grip adapted for non-rotatable fitting onto a motorcycle handlebar end section, the hand grip comprising a hand grip adapted for non-rotatable fitting onto a motorcycle handlebar end section, the hand grip comprising, a hollow cylindrical body having a first, open end; an opposing, second end; and an annular flange projecting radially outwards at the first, open end, the cylindrical body also having an external surface formed with a plurality of projections distributed there over, the projections progressively decreasing in a base area and in height from adjacent the flange to adjacent the second end so as to provide an external taper to the body.

As admitted in the Office Action, Oury merely discloses projections progressively increasing in height from adjacent a flange to adjacent the corresponding section area. In addition to the admitted structural distinction between the applied reference and the claimed subject matter, Oury also discloses a base area of the projections that increases from adjacent to flange to the second end, rather than a base area that decreases as recited in the rejected claims. Although the Examiner admits that Oury does not disclose the features recited in the claims, the Examiner alleges that it was "common knowledge" in the art at the time the invention was made to decrease, rather than increase, the height of projections in order to maximize the amount of torque which may be transmitted from the rider to hand grip. As the Examiner fails to provide evidence to support for the allegations of such common knowledge in the final rejection, the reliance on such common knowledge to support the rejection of the claims is improper.

A second design patent, U.S. Design Patent D461,390 to Livingston, is referred to by the Examiner in what appears to be a Remarks or Comments section, as showing that it is well known to have projections that decrease in height from adjacent to flange to adjacent to second end so as to provide an external taper to the body. However, U.S. Design Patent D461,390 fails to disclose such a feature. Rather, the reference, as in Oury, discloses that the base area increases from the flange end. In Livingston, the base area, after increasing, then decreases at a second

end. Furthermore, in D461,390, the height of the projections increases from the flange, as in Oury. After increases in height, the projections then rapidly decrease at a second end. Finally, there is no disclosure in D461,390 that the reference has projections, which provide an external taper. As each of the references are design patents, there can be no suggestion, which may be drawn from the reference, as the references only disclose the ornamental design configurations shown in the figures.

The same Remarks section further relies on Figs. 2 and 3 of U.S. Patent 5,261,665 to Downey as allegedly showing projections that decrease in height from adjacent a flange to adjacent a second end is well known. As Downey merely discloses elevational views of a die for forming a golf club grip socket, the reference fails to disclose an annular flange on a motorcycle hand grip. Furthermore, the die for forming a golf club grip socket fails to show projections, which decrease in base area from adjacent a flange to adjacent to a second end. Thus, Downey also fails to support the allegation that it is common knowledge to decrease instead of increase the height of projections.

The allegation that the drawings in a design patent can be the basis of an obviousness rejection will also be challenged. MPEP §2125 clearly states that the drawings and pictures can anticipate claims only if they clearly show the structure which is claimed.

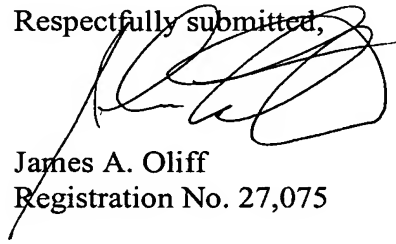
Therefore, based on the foregoing remarks and the remarks set forth in the Amendment After Final Rejection, Applicant contends that claims 1-3 are patentable over any combination of the applied references, or common knowledge.

Applicant will also challenge the refusal to enter certain drawing amendments and amendments to the specification alleging continuing new matter, as the proposed amendments are clearly supported in the original application.

For the reasons set forth above, reconsideration of the Examiner's position is respectfully requested well prior to the May 24, 2005 deadline for filing an Appeal Brief.

The undersigned attorney respectfully requests to attend the pre-appeal brief conference to answer any questions that might arise regarding Applicants' position, and to consider any possible amendments to the claims that may simplify the Appeal or avoid the need for consideration by the Board of Patent Appeals and Interferences. Further, should the Examiners believe that any further comments or clarification would be helpful to resolve the disputed issues in the pre-appeal brief conference, the Examiners are invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: April 20, 2005

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